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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/322,333	05/28/1999	TAKESHI KONDO	1217-990766	7839

7590 01/18/2002

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EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 01/18/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-14

# Office Action Summary

Application No.	Applicant(s)		
Examiner	Group Art Unit		

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 12/6/01
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-4 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-4 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

## Office Action Summary

Art Unit 1771

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-4 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP -355 (Nagamoto et al.) substantially for the reasons set forth in paragraph No. 2 of the final rejection, together with the following additional observations.

The Examiner first would like to emphasize the fact that an anticipation rejection is the most relied upon grounds for rejecting the pending claims. Additionally, applicants' remarks in their latest response, particularly those set forth at page 5 the last three lines, page 6 lines 15-21 and page 7 lines 4-6 are each strenuously disagreed with. Applicants' contention that the most important issue is what the reference considers to be the preferred embodiment of the invention which it describes is simply incorrect. Rather, the proper issue is what is the "closest prior art" to the claimed invention the reference discloses, which in this instance involves the identical coated article referred to at page 2, lines 12-19 of the final rejection. To hold otherwise and instead rely upon the aforementioned statements made by applicants which the Examiner has pointed out would, in essence, make relevant only comparisons versus what the prior art reference, which is possibly directed at solving a different problem, considered to be its most

Art Unit 1771

prominent examples, and would also substantially eliminate the remaining disclosure of the reference, regardless of how pertinent those part or parts of that disclosure might be. Thus, the Examiner must again strenuously disagree with applicants' contention that the reference has failed to "show an example of such a material inherently claiming the claimed performance parameter property".

Finally, it is noted that the amendment to the performance parameter range in claim 1 has eliminated the Examiner's obviousness argument that the parameter's range was not sufficiently distant from the range value which is found in the tested example of the reference.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Serial No. 09/322,333

-4-

Art Unit 1771

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

January 17, 2002

**DANIEL ZIRKER**  
**PRIMARY EXAMINER**  
**GROUP 1300-**  
**1700**

*Daniel Zinker*